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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/689,289 | 10/11/2000 | J. Scott Carr | 60307 | 1154 |

23735 7590 03/14/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

BAYAT, BRADLEY B

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,289

Applicant(s)

CARR ET AL.

Examiner

Bradley Bayat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter is unclear, indefinite and lacks antecedent basis as required by 37 CFR § 1.75(d1):

- Claims 4 and 17 regarding "...withstands at least certain photocopying operations."
- Claims 5 and 18 regarding "...linking to an internet computer site."
- Claims 6 and 19 regarding "...representing a device or user that produced the document."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilham, U.S. Patent 4,934,846.

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As per claims 1, 8-10 and 12-14, Gilham discloses a method of franking mail items (encoding envelopes) with bits of data that are machine-readable and distinguishable from a photocopy and printed on an envelope with the franking mark (see column 1, line 46 – column 2, line 60; column 3, lines 5-27). Gilham discloses the printing mechanism of the franking machine directly onto the envelope as well as various methods of printing the franking impression (see column 3, line 7 – column 5, line 65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6, 7, 15-17, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom et al., U.S. Patent 6,332,194 B1.

As per claims 2-4, 6, 7, 15-17, 19 and 21, Gilham discloses a franking system wherein data is embedded on mail items, readable by an optical scanner and the original distinguishable from a photocopy (see abstract). Gilham does not explicitly teach the use of various forms of watermarking techniques. Bloom et al. teaches a method for data preparation and formation of various watermarks for insertion into a medium with copy protection (see column 5, lines 9-11; column 4, lines 6-45; column 7, line 10-53). Bloom et al. is evidence that one of ordinary skill in the art would recognize the benefit of utilizing various watermarking techniques and multiple watermarks to accomplish several verification or authentication tasks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Bloom et al.

Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz et al., U.S. Patent 5,822,432.

As per claims 5 and 18, Gilham discloses a franking system wherein data is embedded on mail items, readable by an optical scanner and the original distinguishable from a photocopy (see abstract). Gilham does not explicitly teach the use of encoded data to link to a website. Moskowitz et al. teaches a method of encoding digital watermarks to contain a URL, an Internet Protocol Address or an Internet domain name (see column 13, line 30 - column 14, line 6). Moskowitz et al. is evidence that one of ordinary skill in the art would recognize the benefit of utilizing watermarks to directly link to databases, i.e., an internet website. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Moskowitz et al.

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daigneault et al., U.S. Patent 6,334,678 B1.

As per claims 11 and 20, Gilham discloses a franking system wherein data is embedded on mail items, readable by an optical scanner and the original distinguishable from a photocopy (see abstract). Gilham does not explicitly teach the method of applying a second watermark on the opposite side of a substrate where a first watermark was formed. Daigneault et al. teaches a method for applying chemical watermarks on substrate (see column 2, line 13 – column 4, line 13). Daigneault et al. is evidence that one of ordinary skill in the art would recognize the benefit

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of applying multiple watermarks on a substrate. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Daigneault et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Patent No. 6,064,764 to Bhaskaran et al., Fragile Watermarks for Detecting Tampering in Images.
- Patent No. 6,205,373 B1 to Hart et al., Method and System for Tracking Manually Repaired Mailpieces or the Like.
- Patent No. 6,330,672 B1 to Shur, Method and Apparatus for Watermarking Digital Bitstreams.
- Frost article disclosing the use of watermarks for authenticating media.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

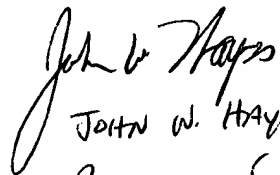
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached Tuesday – Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
March 7, 2003


JOHN W. HAYLES
Primary Examiner